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08/602,503	02/20/96	BALL	M 271605

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EXAMINER
TURNER, K

ART UNIT	PAPER NUMBER
1107	#13

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UNITED STATES DEPARTMENT OF COMMERCE

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 08/602,503

Filing Date: February 20, 1996

Appellant(s): Michael B. Ball

MAILED

DEC 3 1997

GROUP 1100

Robert G. Winkle

For Appellant

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed December 10, 1997.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 21-23 and 25-34 stand or fall together with claim 19 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

✓ 5,323,060	FOGAL et al.	6-1994
✓ 5,399,898	ROSTOKER	3-1995
✓ 5,422,435	TAKIAR et al.	6-1995
✓ 63-179,537	KURODA (JP)	7-1988
✓ 63-104,343	KURANAGA (JP)	5-1988

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19, 21-23, 25-29 and 33 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office action, Paper No. 8.

Claims 30-32 and 34 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office action, Paper No. 8.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

(13) Response to arguments

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For the above reasons, it is believed that the rejections should be sustained.

Applicant begins by arguing that it is not obvious how the references are to be construed. It should first be noted that both Kuroda and Kuranaga would function equally well as the "primary reference." Kuroda illustrates a board and two chips bonded to the board by flip-chip and wire bonding. Kuranaga illustrates four chips, one serving as a base, attached to two other chips by flip-chip and wire bonding and another chip flip-chip bonded to the top chip. Each reference could be taken in view of the other and Fogal to make out the rejection with the stated motivation. On this point, the Court of Customs and Patent Appeals has stated:

In a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of on B in view of A, or to term one reference primary and the other secondary. It would perhaps have saved much argument of the kind we have before us if the Patent Office had stayed with its rejection of the claims as unpatentable over A and B "considered together" and had merely stated its reasons for such rejection without formal alinement of the references. Fifteen years ago this court pointed out in *In re Cowles*, 33 CCPA 1236, 156 F.2d 551, 70 USPQ 419, that such differing forms of expression did not constitute different grounds of rejection, were of little consequence, and that basing arguments on them was "attempting to make a mountain out of a mole-hill."

In re BUSH, 131 USPQ 263, 267 (CCPA 1961).

It should also be noted that although Applicant has cast a dim view on the use of old case law from the Court of Customs and Patent Appeals {Appeal Brief, Paper No. 12, page 11, last paragraph}, holdings of predecessor courts of the Court of Appeals for Federal Circuit, United States Court of Claims and United States Court of Customs and Patent Appeals are binding as precedent in that South Corporation et al. v. United States, 215 USPQ 657 (CA FC 1982).

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Applicant continues by reiterating, from previous responses, the view that Fogal “rejects” alternate methods of mounting chips because Fogal only illustrates wire bonding. Applicant cites the portion of the Fogal patent where the analogous methods of TAB, flip-TAB, and flip-chip bonding are recited. The examiner continues to be of the view that the next sentence in the patent disclosure, “This invention is specific to the distinct art area of wire bonding associated with multichip modules”, is not a rejection of those methods. Applying In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994), as does the applicant, the examiner does not find this statement above to imply “that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” One of ordinary skill in the art would have considered the utility of the methods disclosed by Fogal to other bonding because those methods were spelled out by the reference as being analogous. The fact that Fogal did not illustrate those other methods does not place them outside the skill of one of ordinary skill in the art.

The applicant also seems confused by a statement made in the Final Office Action about the “inventor’s intended use.” The intended use that was being addressed was not that of the applicant, but that of Fogal. A less confusing term would have been patentee and that the intended use of the patentee does not limit the use of that disclosure by one of ordinary skill in the art.


Applicant also argues that the age of the Kuranga and Kuroda implies that there can be no motivation to have combined the references. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing

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that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Finally, applicant accuses the examiner of impermissible hindsight in combining Kuroda, Kuranaga and Fogal with Rostoker and Takiar. Applicant also accuses the examiner of taking "bits and pieces from the prior art" and applying them using Applicant's disclosure as a blueprint. Applicant admits that Rostoker discloses bridging with flip-chip assemblies and Takiar discloses bridging wire bonded assemblies. An examination of claim 31, Appendix A, shows that bridging is claimed and the rejection provides the motivation to the combine the bridging references with the previously used references. The references merely show the obviousness of bridging and require no hindsight taken from Applicant's disclosure.

Respectfully submitted,


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Supervisory Patent Examiner
Patent Examining Group 110

KFT, DECEMBER 23, 1997

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